

### **III. REMARKS**

#### ***Claim Status***

Claims 1, 21 and 25 have been amended. Claims 6, 9 15-20 and 22 have been cancelled. Claims 1-5, 7-8, 10-14 and 21-25 remain pending in the application.

#### ***Claim Objections***

The objection of claim 15 for being a substantial duplicate of claim 1 was maintained for the reasons of record.

Claim 15 has been cancelled.

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 6 has been cancelled.

#### ***Claim Rejections - 35 USC § 112***

Claim 6 stands rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "essentially nonvolatile".

Claim 6 has been cancelled thus obviating this ground for rejection.

**Claims 1-8 and 10-15 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

As stated by the examiner, the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the examiner

cannot find support for the limitation "wherein the ratio of the compound of formula A to the compound of formula B is in the range of from 47:53 to 70:30" that is recited in amended claim 1.

In applicant's response to the previous office action applicant stated that applicant discloses the operative ratios of components of their compositions in Table 1 where the "A" components are the glycols and/or ethers and the "B" components are the di/oligoamines.

Applicant apologizes for not explaining the complete derivation of the figures shown in the table presented in the previous response as support for the claimed ranges. Those numbers were derived as follows.

In TABLE 1, paragraph [0033] of the published application, the designation "A" followed by a number indicates that the component is found in TABLE A, para. [0027] and designates, as stated in the specification at para. [0026], "specific examples of oligo alkylene glycols and related mono ethers useful in the practice of this invention".

In TABLE 1 [paragraph [0033] of the published application, the designation "B" followed by a number indicates that the component is found in TABLE B, [para. [0028] and designates, as stated in the specification at para. [0026], "di/oligoamines and related [amino containing] mono ethers useful in the practice of this invention".

Thus, to determine the ratio of component "A" to component "B" in applicants compositions, one needs to list the quantities of "A" components and the quantities of "B" components in each example and mathematically derive the

percentage of the total of "A" + "B" from the sum of the quantities of "A" components present and of "B" components present.

Stripper Designation Active ingredients (bal. Water)	Composition weight (%)
1A	Prior Art Comparison
1B	Prior Art Comparison
1C	A2 (10), A4 (7), B1 (8)
1D	A3 (16), B6 (7)
1F	A6 (6), A9 (5) B4 (5) B7 (3)
1G	A7 (8.7), A8 (1.8), B9 (12)
1H	A9 (12), B6 (5.4)
1J	A10 (9), A1 (6), B2 (7), B5 (4.5)
1K	A1 (3.7), A3 (2.8), A 9 (2.2), B2 (4.9), B9 (3.8)
1L	A1 (4.1), A3 (3.7), B3 (4), B5 (3.5)

The number in parentheses after each component is the weight percent of that component. The result of adding the amounts of "A" components and the amounts of "B" components is recorded in the table previously presented and reproduced below.

Formulation	Amount "A" Component	Amount "B" Component	% "A"	% "B"
1C	17	8	68	32
1D	16	7	70	30
1F	11	8	58	42
1G	10.5	12	47	53
1H	12	11	52	48
1J	15	11.5	57	43
K	8.7	8.6	50	50
1L	7.8	7.5	51	49

Range A = 47-70%

Range B = 30-53%

Applicants have previously amended claim 1 to recite the ratios set forth in the instant specification. Thus, applicant believes the claim is supported by the specification and respectfully requests favorable reconsideration of this ground for rejection

Claims 1-8, 10-15 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 21 are rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "essentially nonvolatile."

Applicant thanks the examiner for the courtesies extended by the examiner during the telephonic interview of August 26, 2008 wherein it was agreed that deletion of the word "essentially" from the claims would cure this defect and that basis for the amended claim exists in the specification.

Applicant has amended the claims to delete "essentially", thus obviating this ground for rejection of claims 1 and 21 and dependent claims 2-8, 10-14 and 21 and 23-25.

***Claim Rejections - 35 USC § 102(b) and 103(a)***

Claims 1-6 and 13-15 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Long, U.S. Patent No. 4,873,014.

The examiner states that Long, U.S. Patent No. 4,873,014, discloses a pickling composition comprising a polyalkylene polyamine, such as tetraethylene pentamine (see abstract and col. 2, lines 18-37), a polyglycol, such as polyethylene glycol and polypropylene glycol having molecular weights of 200 and

400 (see col. 2, line 38-col. 3, line 5), hydrochloric acid (see col. 3, lines 31-35), and water (see col. 3, line 35), per the requirements of the instant invention.

The examiner asserts that the compositions disclosed in Long would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Long contain all of the required components in the amounts required in the instant claims, absent a showing otherwise.

Applicant respectfully disagrees.

First, the disclosed functionality of Long's composition is its use to inhibit corrosion during acid pickling operations employed in the treatment of iron-containing materials [col. 1, lines 6-8] Applicant's compounds are coating strippers.

Second, the compositions are different in essential aspects.

Applicant does not require 30 to 35% hydrochloric acid.

Applicant requires ratios of glycol to amine in the range of 47 to 70% glycol and 30 to 53% amine, as set forth herein above.

Long requires ratios of glycol to amine in the range of 5 to 35% glycol, preferably 20 to 30% glycol, most preferably 25% glycol (col. 3, lines 20-30) and 65 to 95% amine, preferably at least 70-80% amine, most preferably 75% amine. (Col. 3, lines 9-20).

Thus, applicant requires over 50% more glycol than Long at the closest point of comparison and over 200% more at the far end of the range.

Therefore, instant claims 1-6 and 13-19 are not

anticipated by Long, USP 4,873,014 and applicant respectfully requests reconsideration of this ground for rejection.

In addition, Long does not render applicant's claims obvious since the significantly different compositions are utilized for significantly different purposes.

Applicant respectfully requests favorable reconsideration.

**Claims 1-2, 5-6, and 13-15 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Belcak et al., U.S. Patent No. 3,954,648.**

The examiner has previously argued that it is not clear what amounts of "essentially nonvolatile, caustic free" are excluded from the instant claims.

In response to the previous office action applicant argued that Belcak et al., U.S. Patent No. 3,954,648, requires the presence of a caustic agent, which is excluded in the instant claims and that Belcak et al. does not anticipate these claims nor does it render them obvious because it specifically teaches away from applicants invention.

Belcak et al. is an example of the prior art referred to at para. [0002] of applicant's published specification where caustic plays an essential role in the functionality of the prior art compositions. With the deletion of the word "essentially" from the claim, the claims now read on a completely "caustic free" composition and Belcak et al. is inapposite.

Applicant therefore prays for favorable reconsideration of this ground for rejection.

**Claims 21-25 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Long, U.S. Patent No. 4,873,014.**

Long, U.S. Patent No. 4,873,014, discloses a pickling composition. The examiner asserts that the compositions disclosed in Long would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Long contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Therefore, instant claims 21-25 are anticipated by Long, U.S. Patent No. 4,873,014.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, the examiner argues that it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Applicant respectfully disagrees. Long discloses a different composition having a different functionality.

First, the disclosed functionality of Long's composition is its use to inhibit corrosion during acid pickling operations employed in the treatment of iron-containing materials [col. 1, lines 6-8]. Applicant's compounds are coating strippers.

Second, the compositions are different in essential aspects.

Long describes his composition as an "acid pickling composition" (inter alia, Abstract, col. 4, line 1) A composition having a neutral pH cannot reasonably be considered to be an acid pickling composition.

Lond describes his composition as being an acid pickling

bath having "at least about one weight percent and no greater than about 20 weight percent" acid in diluted form.

In undiluted form Long's composition is preferably 30 to 35% hydrochloric acid. (col. 3, lines 31-35) with the remainder (except 0.3 to 0.5 weight percent) being water.

It is inherent in a composition containing 30 to 35% hydrochloric acid that the pH will not be in the range of 6 to 8.

Further, Long discloses a composition having a polyol/amine concentration of 0.3 to 0.5 weight percent in concentrated form and 0.05 to 0.5 weight percent in diluted form.

Reproducing the table set out herein above highlights the difference between Long's and applicant's compositions.

Formulation	Amount "A" Component (wt. %)	Amount "B" Component (wt. %)	Total Amount "A" + "B" (wt. %)
1C	17	8	25
1D	16	7	23
1F	11	8	19
1G	10.5	12	22.5
1H	12	11	23
1J	15	11.5	26.5
K	8.7	8.6	17.3
1L	7.8	7.5	15.3

The amounts set forth in columns entitled Amount "A" Component and Amount "B" Component are, as previously set forth, in weight percent. This demonstrates that there is at least a 30 fold (3000%) difference in the prior art composition as compared to the currently claimed composition with regard to the quantities of the polyol and amine components.



Applicant has amended claim 21 to recite the presence of a minimum quantity of "A" Component and "B" Component, corresponding to the lowest quantity present in the examples in the table, above (15.3%).

Therefore, instant claims 21 and 23-25 are not anticipated by Long, USP 4,873,014 and applicant respectfully requests reconsideration of this ground for rejection.

In addition, Long does not render applicant's claims obvious since the significantly different compositions are utilized for significantly different purposes.

**Claims 21-25 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Belcak et al, U.S. Patent No. 3,954,648.**

The examiner asserts that the compositions disclosed in Belcak et al would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Belcak et al. contain all of the required components in the amounts required in the instant claims, absent a showing otherwise.

Therefore, the examiner concludes the instant claims are anticipated by Belcak et al.

In response, applicant states that Belcak et al. requires the presence of a caustic agent, which is specifically excluded in the instant claims. As the components are different, Belcak et al. does not anticipate applicant's invention.

The examiner states that, in the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled

artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Belcak et al. is an example of the prior art referred to at para. [0002] of applicant's published specification where caustic plays an essential role in the functionality of the prior art compositions. With the deletion of the word "essentially" from the claim, the claims now read on a completely "caustic free" composition and Belcak et al. is inapposite. It would not be obvious to remove an essential component of the prior art composition and expect it to retain its functionality.

Applicant therefore prays for favorable reconsideration of this ground for rejection.

**Claims 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagoshi et al, U.S. Patent No. 5,958,298.**

As stated by the examiner, Nagoshi et al., USP 5,958,298, disclose an anti-corrosive draining agent comprising a glycol ether, an amine compound and adjunct ingredients, such as surfactants per the requirements of the instant invention.

Applicant respectfully traverses this ground for rejection.

Nagoshi et al. disclose a rinsing solution of polyoxyalkylene alkyl ether and amine where the ratio of the two components is from 1 to 20% ether and from 80 to 99% amine. [Abstract, col. 2, lines 36-40 and lines 62-67 and Examples 1-17]. Nagoshi et al. find this ratio satisfactory for their

purpose, which is different from applicants. Nagoshi et al. disclose anti-corrosive draining agents, not applicant's VOC free strippers.

In applicant's response to the previous office action applicant stated that applicants disclose the operative ratios of components of their compositions in Table 1 where the "A" components are the glycols and/or ethers and the "B" components are the di/oligoamines.

Applicant apparently did not explain the complete derivation of the figures shown in the table presented in the previous response. Those numbers were derived as follows.

In TABLE 1 [paragraph [0033] of the published application, the designation "A" followed by a number indicates that the component is found in TABLE A [para. [0027] and designates, as stated in the specification at para. [0026] "specific examples of oligo alkylene glycols and related mono ethers useful in the practice of this invention".

In TABLE 1 [paragraph [0033] of the published application, the designation "B" followed by a number indicates that the component is found in TABLE B [para. [0028] and designates, as stated in the specification at para. [0026] "di/oligoamines and related mono ethers useful in the practice of this invention".

Thus, to determine the ratio of component "A" to component "B" in applicants compositions, one need to list the quantities of "A" components and the quantities of "B" components in each example and mathematically derive percentage of the total of "A" + "B" of each of the sum of the

quantities of "A" components present and of "B" components present.

Stripper Designation Active ingredients (bal. Water)	Composition weight (%)
1A	Prior Art Comparison
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1K	A1(3.7), A3 (2.8), A 9(2.2), B2(4.9), B9(3.8)
1L	A1 (4.1), A3(3.7), B3(4), B5(3.5)

The number in parentheses after each component is the weight percent of that component. The result of adding the amounts of "A" components and the amounts of "B" components is recorded in the table previously presented and reproduced below.

Formulation	Amount "A" Component	Amount "B" Component	% "A"	% "B"
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1J	15	11.5	57	43
K	8.7	8.6	50	50
1L	7.8	7.5	51	49

Range A = 47-70%

Range B = 30-53%

Applicants have previously amended claim 1 to recite the ratio set forth in the instant specification. As the compositions disclosed in Nagoshi et al. do not contain the amounts of the components required in the instant claims, Nagoshi et al. do not anticipate the present claims.

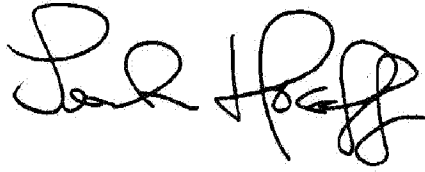
The examiner further states that, in the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

As demonstrated above, the basis for the rejection, that "the reference teaches each of the claimed ingredients within the claimed proportions for the same utility" is not correct and applicant respectfully prays for favorable reconsideration of this ground for rejection.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that the claims are in condition for allowance and passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper, not already paid through an EFS-Web filing, may be charged to Deposit Account No. 50-3894. Any overpayment may be credited to Deposit Account No. 50-3894.

Respectfully submitted,  
MYERS WOLIN, LLC

A handwritten signature in black ink, appearing to read 'Serle Mosoff', written over a horizontal line.

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